

### **REMARKS**

Claims 1-40 are pending. By this amendment, claims 7, 10, 22, and 25 are amended. No new matter is introduced. Support for the claim amendment can be found at least in original claims 10 and 25. Reconsideration and allowance of the claims in view of the above-amendments and the remarks that follow are respectfully requested.

#### **Rejection under 35 U.S.C. § 103**

Claims 1-6, 16-21, and 27-40 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,621,456 to Florin (hereafter Florin) in view of U.S. Patent 5,715,315 to Handelsman (hereafter Handelsman). This rejection is respectfully traversed.

Florin is directed to a method and apparatus for providing an interactive audio-visual interface for the display of multiple program categories. Handelsman is directed to a CATV system that transmits encrypted information individually addressed to a subscriber unit. However, Florin and Handelsman, individually and in combination, do not disclose or suggest “the electronic mail is transferred from the set top converter for processing ... a memory for storing interactive programming instructions; and at least one microprocessor connected to said memory and connected to said interface for accessing the stored interactive programming instructions and for processing the electronic mail to produce processed electronic mail based on the stored interactive programming instructions” as recited in claim 1.

The Examiner asserts on pages 2-3 of the Office Action that Florin discloses an interface for providing an electrical connection to the STB, whereby the e-mail is transferred from the STB for processing. The Examiner further asserts that Florin and Handelsman disclose a memory for storing interactive programming instructions and a microprocessor connected to the memory and the interface for accessing the stored interactive programming and for processing the e-mail to produce processed e-mail based on the stored interactive programming instructions. Applicants respectfully disagree.

Florin describes, in column 8, lines 52-55, that the transceiver 54 comprises an optional compact disc read only memory (CD ROM) module 70 and a system memory 65. However, neither the CD ROM module nor the system memory store interactive programming instructions. Similarly, Handelsman’s system merely enables subscribers to transmit encrypted information over the CATV (see abstract, column 1, lines 61-67 and column 9, lines 15-25 of Handelsman).

Nowhere in the cited language does Handelman disclose or suggest that the memory stores interactive programming instructions.

Furthermore, Florin and Handelma, individually and in combination, do not disclose or suggest that the processor processes the electronic mail to produce processed electronic mail based on the stored interactive programming instructions. Florin merely discloses a CPU 63. As noted above, Florin does not disclose interactive program instructions, let alone a processor that processes the electronic mail to produce processed electronic mail based on the stored interactive programming instructions. Similarly, Handelman recites, in column 8, lines 38-67, that a processor 156 provides fax data, E-mail data, voice-mail data and mail data to either of an internal memory unit 156 or an external memory module 160, and receives data input by a subscriber via keyboard 130 and prepared it in a suitable format for transmission as fax, E-mail or mail data via telephone link 152. Nowhere does Handelman disclose or suggest processing the electronic mail based on the stored interactive programming instructions.

Since none of the cited references disclose or suggest each and every element of the claims, a combination of the cited references also does not teach or suggest each and every element of the claims. To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) must teach or suggest all of the claim limitations. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP § 2142. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and MPEP § 2143.03. Therefore, claim 1 is allowable.

Claims 2-6 are allowable because they depend from allowable claim 1 and for the additional features they recite. Applicants therefore respectfully request withdrawal of the rejection of claims 1-6 under 35 U.S.C. §103 (a).

With respect to claim 16, for the same reason as noted above with respect to claim 1, Florin and Handelman, individually and in combination, do not disclose or suggest "the electronic mail is transferred from the set top converter for processing; storing interactive programming instructions; ... processing the electronic mail to produce processed electronic mail based on the stored interactive programming instructions" as recited in claim 16. Therefore, claim 16 is allowable.

Claims 17-21 are allowable because they depend from allowable claim 16 and for the additional features they recite. Applicants therefore respectfully request withdrawal of the rejection of claims 16-21 under 35 U.S.C. §103 (a).

With respect to claim 27, Florin and Handelman, individually and in combination, do not disclose or suggest “generating menus from the menu control information ... integrating the electronic mail into menus” as recited in claim 27. Claim 27 is rejected on page 5. However, this feature of integrating electronic mail into menus is not specifically addressed by the Examiner in rejecting claim 27, and Applicants contend that this feature is novel in view of the cited references. Therefore, claim 27 is allowable.

Claims 28-30 are allowable because they depend from allowable claim 27 and for the additional features they recite. Applicants therefore respectfully request withdrawal of the rejection of claims 27-30 under 35 U.S.C. §103 (a).

With respect to claim 31, for the same reason as noted above with respect to claim 1, Florin and Handelman, individually and in combination, do not disclose or suggest “at least one memory for storing the electronic mail and for storing interactive programming instructions; at least one processor connected to the memory and the subscriber interface for accessing the stored interactive programming instructions and for executing the stored interactive programming instructions to produce interactive signals which include electronic mail” as recited in claim 31. Therefore, claim 31 is allowable.

Claims 32-35 are allowable because they depend from allowable claim 16 and for the additional features they recite. Applicants therefore respectfully request withdrawal of the rejection of claims 31-35 under 35 U.S.C. §103 (a).

With respect to claim 36, for the same reason as noted above with respect to claim 1, Florin and Handelman, individually and in combination, do not disclose or suggest “storing interactive programming instructions ... executing the stored interactive programming instructions to produce interactive signals which include electronic mail” as recited in claim 36. Therefore, claim 36 is allowable.

Claims 37-40 are allowable because they depend from allowable claim 36 and for the additional features they recite. Applicants therefore respectfully request withdrawal of the rejection of claims 36-40 under 35 U.S.C. §103 (a).

Claims 7-9 and 22-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,331,877 to Bennington (hereafter Bennington). This rejection is respectfully traversed.

Claims 7 and 22 are amended to incorporate a portion of the subject matter of original claims 10 and 25, respectively. Claims 10 and 25 are rejected on page 9 of the Office Action. The Examiner asserts that it was well known in the art to combine e-mail service with a subscription TV service, as is shown by Handelman. However, Handelman and Bennington, individually and in combination, do not disclose or suggest “executing the stored interactive programming instructions to produce electronic mail signals” as recited in amended claim 7. The abstract of Handelman merely noted that the CATV system transmits encrypted information individually addressed to a subscriber unit. Handelman’s CATV system does not execute interactive programming instructions to produce electronic mail signals. The feature of executing the stored interactive programming instructions to produce electronic mail signals is not specifically addressed by the Examiner in rejecting claims 10 and 25, and Applicants contend that this feature is novel in view of the cited references. Since the references do not disclose or suggest all of the elements of amended claim 7, claim 7 is allowable.

Claims 8-9 are allowable because they depend from allowable claim 7 and for the additional features they recite. Applicants therefore respectfully request withdrawal of the rejection of claims 7-9 under 35 U.S.C. §103 (a).

With respect to claim 22, for the same reason as noted above with respect to claim 7, the references do not disclose or suggest “executing the stored interactive programming instructions to produce electronic mail signals” as recited in amended claim 22. Therefore, claim 22 is allowable.

Claims 23-24 are allowable because they depend from allowable claim 22 and for the additional features they recite. Applicants therefore respectfully request withdrawal of the rejection of claims 22-24 under 35 U.S.C. §103 (a).

Claims 10-15 and 25-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bennington in view of Handelman. This rejection is respectfully traversed.

Claims 10-11 are allowable because they depend from allowable claim 7 and for the additional features they recite. Applicants therefore respectfully request withdrawal of the rejection of claims 10-11 under 35 U.S.C. §103 (a).

Claims 25-26 are allowable because they depend from allowable claim 22 and for the additional features they recite. Applicants therefore respectfully request withdrawal of the rejection of claims 25-26 under 35 U.S.C. §103 (a).

With respect to claim 12, for the same reason as noted above with respect to claim 27, the references do not disclose or suggest "a menu generator for generating menus from the menu control information; a subscriber interface for interactively entering information using said generated menus; ... a text and graphics video plane combiner for integrating the electronic mail into menus" as recited in claim 12. Claim 12 is rejected on page 9. However, this feature of integrating electronic mail into menus is not specifically addressed by the Examiner in rejecting claim 12, and Applicants contend that this feature is novel in view of the cited references. Therefore, claim 12 is allowable.

Claims 13-15 are allowable because they depend from allowable claim 12 and for the additional features they recite. Applicants therefore respectfully request withdrawal of the rejection of claims 12-15 under 35 U.S.C. §103 (a).

For at least the reasons set forth above, applicants respectfully submit that this application is in condition for allowance. Favorable consideration and prompt allowance of the claims are earnestly solicited.

Should the Examiner believe that anything further is desired in order to place the application in even better condition for allowance, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



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